UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,308	01/19/2001	Takanori Tcrada	1046.1232/JDH	6758

21171	7590	08/09/2006	

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EXAMINER
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ART UNIT	PAPER NUMBER
2144	

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/764,308	TERADA, TAKANORI
	Examiner	Art Unit	
	Michael S. A. Delgado	2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>04/17/2006</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1,2,4-6,8-11,13-15,17-20,22-24,26 and 27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1,2,4-6,8-11,13-15,17-20,22-24,26 and 27</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>27 September 2004</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All   b) ☐ Some * c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claims 1-2, 4-6, 8-11, 13-15, 17-20, 22-24 and 26-27 are rejected under 35 U.S.C. 103(a)

as being unpatentable over US Patent No. 6,721,785 by Raghunandan and US Patent No.

7,039,639 by Brezin et al in view of US Patent No. 6,574,671 by Haynes.

In claim 1, Raghunandan teaches about an E-mail device comprising (Fig 2):

a first detection module (program that link alias to recipient email addresses) of detecting

that a plurality of multicast target mail destination addresses exist in a stored mail delivery

history (Col 1, line 65-Col 2, line 5) (Col 4, lines 48-55); (Alias are stored in advance to reduce

the burden of entering individual email).

an adding module "inclusion directive" of adding the group name corresponding to the

plurality of multicast target mail destination addresses of the destination attribute to group

management information (Col 5, lines 45-60); and

a generating module (the function of defining the recipient of the email message) of

executing a process of generating a group formed of the plurality of multicast target mail

destination addresses " alias41.... Alias4n", corresponding to the detection (Col 5, lines 60-67)

(Col 6, lines 10-20 (Col 2, lines 1-5); (Alias or grouping is done to associate a plurality of email

addresses that have the same characteristic or attribute). But does not explicitly teach about the

group generating process being done using all destination attributes nor a setting module setting

an input count of the mail destination addresses in the history in order to register the added group

name. Haynes teaches about a simpler generation process that generates a group base on all the

destination attributes ("To" "BCC" and "CC") (Col 5, lines 30-60). The approach of

Raghunandan generates a group base on n number of groups alias, and with n being a large

number, a large amount of overhead processing power is required to generate a group (Col 6,

lines 5-35). The group is created prior to the mail being delivered. The less granular approach of

Haynes requires less processing which reduces the time taken before mail delivery.

Raghunandan teaches about creating a group base on recipients that are frequently

contact. To determine which recipients are frequently contacted, there has to be an element of

counting. Brezin et al teaches about a simple frequency count in optimizing user behavior (Col 3,

lines 50-65).

It would have been obvious at the time of the invention for some of ordinary skill to

improve on the time taken to delivery a mail in Raghunandan invention by using the less

granular approach of Haynes invention while optimizing the grouping process of Raghunandan

using the counting approach of Brezin et al.

In claim 2, Raghunandan and Brezin combined with Haynes, teaches about the E-mail

device according to claim 1, further comprising a second detection module detecting that there

does not exist a group corresponding to the plurality of multicast target mail destination

addresses existing in the history (Raghunandan Col 5, lines 35-60) (detection module- i.e. the function that determine that a selection command is active, which indicates that a intended group is not available and therefore has to be created base on the accompanying directives).

wherein if there does not exist a group corresponding to the plurality of multicast target mail destination addresses , said generating module generates the group (Raghunandan Col 5, lines 45-60).

In claim 4, Raghunandan and Brezin combined with Haynes, teaches about the E-mail device according to claim 1, wherein said adding module includes a providing module registering the added group name corresponding to the plurality of multicast target mail destination addresses (Raghunandan Col 4, lines 48-55). (This is function that is used when creating alias).

In claim 5, Raghunandan and Brezin combined with Haynes, teaches about the E-mail device according to claim 4, wherein said adding module further includes a first registering module registering the added group name inputted by a user in the group management information in the registering the added group name "alias" (Raghunandan Col 1, line 65- Col 2, line 5).

In claim 6, Raghunandan and Brezin combined with Haynes, teaches about the E-mail device according to claim 5, wherein said adding module further includes a second registering

module registering a piece of registration reject state information in the group management

information when the user rejects the registration of the added group name in the registering the

added group name (Raghunandan Col 3, lines 30-40). (the exclusion directive that remove names

from the final list)

In claim 8, Raghunandan and Brezin combined with Haynes, teaches about the E-mail

device according to claim 1, wherein said adding module generates the group name by a

predetermined algorithm "rules" and adds this group name to the group management information

(Raghunandan Col 5, lines 45-60).

In claim 9, Raghunandan and Brezin combined with Haynes, teaches about an E-mail

device according to claim 1, further comprising a selecting module "selection command" of

enabling the user to select whether the process of generating the group is to be executed or not

(Raghunandan Col 5, lines 45-60).

Claims 10-11, 13-15 and 17-18 are the method to the device of claims 1-2, 4-6 and 8-9

respectively and are rejected for the same reason.

Claims 19-20, 22-24 and 26-27 are the readable computer medium, which stores the

executable program that execute the method to the device of claims 1-2, 4-6 and 8-9 respectively

and are rejected for the same reason.

Response to Arguments

Applicant's arguments include the failure of previously applied art to expressly disclose a

setting module setting an input count of the mail destination addresses in the history in order to

register the added group name. See Response, Remarks dated 04/17/2006, pages 7-8. It is

evident from the detailed mappings found in the above rejection(s) that Brezin et al. disclosed

this functionality by counting the frequency of an event in order to optimize a system. Further, it

is clear from the numerous teachings (previously and currently cited) that the provision for

counting the number of times that a Email destination was used by a sender, was widely

implemented in the networking art. Thus, Applicant's arguments drawn toward distinction of the

claimed invention and the prior art teachings on this point are not considered persuasive.

Conclusion

1.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

US Patent 6,289,372 by Vyazniko teaches about a method for transmitting and processing

group messages in the e-mail system.

US Patent 6,289,372 by Rothschild et al teaches about a server-group messaging system

for interactive applications.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Michael S. A. Delgado whose telephone number is (571)272-

3926. The examiner can normally be reached on 7.30 AM - 5.30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, William C. Vaughn Jr. can be reached on (571)272-3922. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MD

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